

REMARKS

In this response, Applicant will attempt to respond to the Office Action in the same order as set forth in the Office Action.

I. Declaration Under 37 CFR 1.131

The Examiner contends that the Declaration and Exhibits provided by Applicant do not demonstrate that the concept of all of the limitations in the claimed invention were conceived prior to February 3, 2000.

Before addressing the specifics of the Examiner's contentions, Applicant notes that the critical date needed to overcome the Keen reference is February 29, 2000 as explained in detail at page 8 of Applicant's response filed December 23, 2009. Thus, in order to prove that Applicant had possession of the invented concept, it must be demonstrated that Applicant had possession of the concepts prior to February 29, 2000. In this connection, Applicant notes that in the Declaration filed December 23, 2009, it is clearly stated that Applicant downloaded Exhibits 9, 11 and 12 on February 3, 2000, and downloaded Exhibit 14 on February 23, 2000. With respect to the specific items referenced by the Examiner in the Action, Applicant submits that Exhibits 9, 11, 12 and 14 show that Applicant had possession of the concept as set forth in the Action at least as early as February 23, 2000, which is prior to the critical date of February 29, 2000.

Regarding the specific elements mentioned by the Examiner at pages 2-3 of the Action, Applicant responds as follows:

1. "Contact information of the receiver is hidden from the communication device."

In response, one of the important aspects of the present invention is to provide a system whereby fans of celebrities can communicate directly with a star or other famous person in

exchange for a payment. See for example paragraph [0029] of the published application. Thus, it is apparent that one of the important aspects of the present invention is to include a mechanism by which a user or fan can send a text message to a receiver or famous person for a fee paid by the user, which would necessarily be impossible if the contact information of the receiver or star is not kept hidden from the user or fan. That is, Applicant realized that in order to enable fans to communicate with a famous person, it would be necessary for the contact information of the famous person to be maintained private. For this reason, while conducting research on how to implement the invention, as set forth, for example, in Exhibit 14 which Applicant downloaded on February 23, 2000, i.e., The User's Guide To "FormMail Version 1.6", on the third page of the Exhibit, under the heading "Necessary Form Fields" it is noted that there is only one Form Field which is necessary which is the Recipient Field, which can be configured to be a hidden form field. Thus, as Applicant affirmatively states in the Declaration filed December 23, 2009 the invention was conceived on or about February 3, 2000, including the concept of hiding the receiver's (i.e., famous person) the email address and tracking the user (i.e., the fan), absent which the invention would make no sense and have no real purpose or utility (see paragraph 4 and 5 of the Declaration filed December 23, 2009). Exhibit 11 and 12 downloaded by Applicant on February 3, 2000 also shows that this aspect of the invention was conceived by Applicant prior to the critical date of February 29, 2000 as explained at paragraphs 7-13 of the Declaration filed December 23, 2009.

Exhibit 14 downloaded February 23, 2000 also supports possession of this concept as explained at paragraph 16-20 of the Declaration filed December 23, 2009.

2. “Identification information of the user is tracked from the test communication from the user.”

Applicant notes that the relevant element, as set forth in Claim 21 reads as follows:

“Identification of the user is tracked for a return text communication from the receiver.”

That is, the identification information is tracked for a return text communication, not “from” the text communication. In response, Applicant submits that possession of this concept prior to the critical date is clearly demonstrated by the fact that Exhibit 11 downloaded by Applicant on February 3, 2000 at page 3 demonstrates that Applicant was seeking to determine techniques for implementing this aspect of the invention. For example, at page 3 under Field: recipient, it is stated:

“Description: this form field allows you to specify to whom you wish for your form results to be mailed. Most likely you will want to configure this option as a hidden form field with a value equal to that of your e-mail address.”

3. “Transferring of fee to the receiver, or charity on behalf of the receiver”

With respect to this aspect of the invention, Applicant notes that none of the claims contain this precise limitation. Claims 32 and 40 contain limitations of a somewhat similar nature.

4. “Contact of the receiver is an account or and (sic) address” is somewhat similar to a limitation set forth in dependent claim 25.
5. “Receiving conformation of delivery of the text by a user” is expressed in dependent claim 28.

Although the documents downloaded prior to the critical date do not appear to expressly refer to these aspects of the invention as defined in some of the dependent claims, Applicant

notes that such aspects are clearly inherent in view of the entirety of what Applicant was attempting to accomplish. That is, without being able to transfer a fee to the receiver, or star, or wherein the contact information of the receiver is an account or an address, or receiving confirmation of delivery are so essential (as to the first two) or important (as to the third), that the entire purpose of the invention would have been thwarted if Applicant had not conceived of these elements as being critical to the success of the invention. That is not to say that Applicant had reduced to practice precisely how to implement these elements prior to the critical date, however, without these elements being part of the invention conceived by Applicant prior to the critical date, there would be no purpose to the invention.

As such, Applicant submits that the Declaration filed December 23, 2009, and at least its supporting Exhibits 11, 12 and 14 demonstrate that Applicant had possession of the invented concept prior to the critical date of February 29, 2000.

III. Response to Arguments

In Response to Arguments at page 4 of the Action, the Examiner contends that the disclosure filed by the Applicant does not teach tracking of the user identification for a return text from the receiver (whose contact information is hidden) to whom said user sent a message, nor does Exhibit 5.

In response, with respect to the Examiner's contention that the disclosure filed by Applicant does not teach the foregoing element, reference is made, for example, to paragraph [0165] wherein it is stated that "the Merchant Intermediary can agree to protect the Receiver party's privacy, encrypt the address or location of the Receiver party so that it is unknown to the Caller party, . . ." As to the Examiner's contention regarding Exhibit 5, Applicant notes that Exhibit 5 states "Privacy and security are respected. Respond to the most interesting or enticing.

Communicate with and see pictures of your fans.” Applicant submits that such sentences, among others, clearly show this aspect of the invention.

IV. Claim rejections – 35 USC 112, first paragraph.

In the Action, the Examiner contends that Applicant’s disclosure does not disclose: “contact information of the receiver is hidden from the communication device.”

Applicant notes that this appears to be a new contention by the Examiner. However, the Examiner is referred to paragraph [0165] of the published specification. As to the remaining elements allegedly not disclosed by Applicant, Applicant notes that in the prior Office Action the Examiner made the same assertion. In Applicant’s response to the prior Office Action, Applicant provided a full explanation demonstrating that at paragraphs [0139] – [0152] as to how such elements are adequately disclosed. See pages 7-8 of the prior Response to Office Action. In this Action, the Examiner has made no attempt to refute the information as provided in the Response to the prior Office Action at pages 7-8. As such, Applicant submits that there is no need to further respond in this Office Action as Applicant incorporates by reference its prior Response to the same grounds for rejection in the Response to Office Action filed December 23, 2009.

IV. Claims Rejections – 35 USC 103(a)

Claims 21-46 are rejected under 35 USC 103(a) as being unpatentable over Cook in view of Keen.com. In response, it is noted in Applicant’s Response filed December 23, 2009, the pages relied upon by the Examiner in Keen, namely pages 10-14, are dated February 29, 2000. Since as noted above, Applicant has responded to the Examiner’s contention that the Declaration previously filed by Applicant did not establish conception of the invention prior to February 29, 2000, Applicant requests that Keen be withdrawn as a basis for rejecting the claims under 35

USC 103(a). In this connection, since Keen is needed to support the rejection of independent Claims 21, 31 and 39, reconsideration and withdrawal of the rejection of independent Claims 21, 31 and 39 is requested since the primary reference Cook does not teach selecting a receiver to receive text as acknowledged by the Examiner, Cook cannot be relied upon as the basis for rejecting the claims under 35 USC 103(a).

At pages 8-9 of the Action, the Examiner rejects Claims 22-30 and 32-38 and 42-46 based upon Rochkind in view of Clark. It is believed that this aspect of the rejection, which is repeated at pages 11-12 was intended to be part of the rejection of Claims 21-46 as being unpatentable under 35 USC 103(a) over Rochkind in view of Clark as stated at pages 10-12 of the Action.

In response, Applicant notes that the essential elements of the present invention are the ability of a user (e.g., a celebrity fan) to send a text message, through an intermediary, for a fee, to a receiver (e.g., celebrity) wherein contact information of the receiver (celebrity) is hidden and the identification of the user (fan) is tracked for a return text communication from the receiver (celebrity).

The Examiner notes that Rochkind teaches a system and method for connecting a communication device with an intermediary facility, but notes that Rochkind does not explicitly recite hiding contact information of the receiver, and relies upon Clark which teaches that to enforce privacy, it does not give contact information of the sender and receiver.

However, the combination of these two references would not yield the invention. In particular, referring for example to Figure 2 of Rochkind, Rochkind seems to be directed to the situation where a party having an unlisted messaging address originates a message from the unlisted address which is sent to a receiver who can reply to the received message, but cannot

originate new messages destined for the party who originally sent the message. For one thing, this is precisely opposite to the teachings of the invention, wherein the original sender of the message desires that his or her address be known by the recipient, and it is the recipient who wants to ensure that when responding, the recipient's address is hidden when it is sent to the sending party. Although Rochkind apparently contemplates the sending party, who desires an unlisted address, may pay a fee for such privilege, according to the present invention, it is the original sender who pays the fee, not the recipient, who receives the fee paid by the sender. That is, unlike Rochkind, the entity with the hidden address does not pay a fee, but, in fact, receives a fee which fee is based upon the fact of having a message sent rather than being based upon having an unlisted address.

Although Clark does seem to contemplate enabling communications between a sender and receiver, both of whom have addresses which remain private, and presumably in exchange for a fee, such communication is limited to placing a phone call, and does not contemplate sending text.

Accordingly, reconsideration and withdrawal of the rejections under 35 USC 103(a) is requested.

Accordingly, Applicant submits that the claims pending following entry of this response, namely Claims 21-46, are now in condition for allowance, which early action is requested.

If there are any additional fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666. If a telephone interview would expedite the prosecution of this Application, the Examiner is invited to contact the undersigned at (310) 207-3800.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being submitted electronically via EFS Web to the United States Patent and Trademark Office on the date shown below.

Linda Metz

